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EXAMINER

VYAS, ABHISHEK

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/944,549
Filing Date: August 31, 2001
Appellant(s): CHAUVIN ET AL.

Eugene I. Shkurko
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/21/2009 appealing from the Office action mailed 02/24/2005

(1) Real Party in Interest

Eastman Kodak Company, the assignee of the present application, is the real party in interest.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Shiota et al US PATENT No.: 6,324,521 11-2001

Jury et al US PATENT No.: 5,918,054 06-1999

Takemoto US Patent Application Publication No.: 2002/0036696 01-2003

Nguyen et al US Patent Application Publication No.: 2003/0005132 01-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-5, 10, 11, 13, and 17-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,324,521 (hereinafter "Shiota") in view of U.S. Patent Application No. US 2003/0005132 A1 (hereinafter "Nguyen").

Regarding claim 1, Shiota discloses a method of selecting a digital photographic service provider from a plurality of different service providers and providing a photographic image service with respect to at least digital

image located at a user location remote from said selected photographic service provider, comprising: providing a services directory (see column 3, lines 5- 10); said user providing criterion for selection of a service provider (see column 2, lines 29-33); automatically provider a list of service providers; selecting one or more service providers (see column 3, lines 5-18); providing a request for a desired service; and providing of said desired service (see column 4, lines 28-32);

Regarding claim 2, the criterion comprises a location of a designated recipient (see column 9, lines 17-20);

Regarding claim 3, the criterion includes specific product characteristics (see column 3, lines 8-10);

Regarding claim 4, list is accomplished through the use of a locator system (see column 2, lines 4-9);

Regarding claim 5, said list includes service information for each of the service providers (see column 3, lines 5-10);

Regarding claim 10, displaying a list of service providers (see column 3, lines 5-10);

Regarding claim 11, said criterion is directly associated with the data included in the digital image file (see column 3, lines 8-10);

Regarding claim 13, the service provider is positioned on a display screen according to a business criteria (see column 3, lines 8-10);

Regarding claim 17, selecting digital images digital images captured by a digital camera (see column 3, lines 31- 36);

Regarding claim 18, the selected service is producing hardcopy prints of the selected images (see column 3, lines 31-35); and

Regarding claim 19, the step of selecting a print quantity for the selected images (see column 3, lines 31-36).

Regarding claim 20, Shiota discloses a system for providing imaging services over a communications network as set forth above in detail for claim 1.

Regarding claim 21, Shiota discloses a computer software product for linking a digital camera user to a Service provider selected from a plurality of service providers as set forth above in detail for claim 1.

Regarding claim 22, Shiota discloses a method of linking a digital photographic imaging service requester to a service provider selected from a plurality of different service providers that are registered in a member system as set forth above in detail for claim 1.

Shiota fails to disclose the use of services directory that contains a list of unrelated service providers.

Nguyen teaches the use of providing a list of unrelated service providers (see paragraph 0040).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota with a list of unrelated service providers

as taught by Nguyen, because providing a list of unrelated service providers gives the customer greater control and choice to pick the service provider best suited to meet his or her needs.

3. **Claims 6-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of Nguyen as applied to claims 1-5, 10, 11, 13, and 17-22 above, and further in view of U.S. Patent No. 5,918,054 (hereinafter "Jury").

Shiota/Nguyen disclose all the claimed elements as set forth above but fails to explicitly disclose use of trademark icons associated with each of the listed service providers.

Jury teaches the use of associating trademark icons with each of the providers (see column 4, lines 45-49).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota/Nguyen with the trademark icons taught by Jury, because trademark icons provide visual confirmation of the service provider, wherein allowing customers to better recognize a particular service provider.

4. **Claims 12 and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of Nguyen as applied to claims 1-5, 10, 11, 13, and 17-22 above, and further in view of U.S. Patent Application No. US 2002/0036696 (hereinafter "Takemoto").

Shiota/Nguyen disclose all the claimed elements as set forth above but fails to explicitly disclose use of data that includes the camera manufacturer.

Takemoto teaches the use of identifying a camera model for purposes of image processing (see ABSTRACT).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota/Nguyen with camera model (manufacturer) information as taught by Takemoto, because model information allows for the elimination of an effect of a tone characteristic and color characteristic caused by a specific camera model (see ABSTRACT).

5. **Claims 14 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of Nguyen as applied to claims 1-5, 10, 11, 13, and 17-22 above, and further in view of Examiner's assertion of Official Notice.

Regarding claim 14, Shiota/Nguyen fails to explicitly disclose the use of determining the retailer of a camera to determine an image service provider. The Examiner takes Official Notice that retailer information is old and well known data to collect when provider service on products purchased at a retail store.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota/Nguyen with retailer data criterion as is well known in the art, because retailers bundle products and their service/maintenance.

Regarding claim 16, Shiota/Nguyen fails to explicitly disclose the use of determining a language selected by a user as business criteria. The Examiner takes Official Notice that language criteria is old and well known in the art of electronic commerce.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Shiota/Nguyen with language data as is well known in the art, because electronic commerce over a wide area network allows user having knowledge various languages and it will be courteous to the customer to provide additional options of service.

(10) Response to Argument

Appellant argues that the claimed invention can be distinguished from the Shiota reference by at least the following points:

- 1) the user provides a criterion to the service provider with respect to providing a selection of a service provider;
- 2) that a list of providers is provided to the user based on the criterion provided by the user; and
- 3) that the list comprises one or more unrelated different service providers.

(see page 6 of Appeal Brief)

Appellant specifically argues that Shiota does not teach the user provide a criterion to the service provider for obtaining a list of service providers. The Examiner

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notes that in claim 1, limitation b states "said user providing a criterion to said server over said communication network for selection of a service provider" and limitation c states "automatically providing the user with a list of one or more of said plurality of unrelated different service providers based on said criterion for display on a user device". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., user providing a criterion to the service provider for obtaining a list of service providers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is clear from the claim language that a list of at least one service provider (i.e. providing one service provider or a list of one service provider) may be provided to the user based on the criterion supplied by the user. The claim does not require obtaining a list of service providers based on criterion provided by the user as argued by Appellant. In addition, Shiota discloses (in col. 3 lines 5-10) that the laboratory (i.e. service provider) is selected based on the order supplied by the customer including an order where special equipment required to complete the order (i.e. criterion supplied by the user) is present at that laboratory. The special equipment required to complete the order is the criterion provided by the user. It is the special equipment which allows the central server in Shiota to determine which laboratory is selected to complete the order.

Second, Appellant argues that a list of service providers in Shiota is based on an existing affiliation that this list is not provided in response to a criterion. However, Shiota

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discloses that when the order file is received from the user, the server selects the laboratory (i.e. service provider) best suited for carrying out the order. Clearly, the service provider is provided based on the provided user criterion. As explained by Appellant on the bottom of page 6 of the Appeal Brief, last sentence and page 7, first paragraph, in Shiotu, when the customer wishes to receive the print over the counter, the order information data shows the laboratory at which the print is received is referred to (i.e. list of one or more service providers) and the laboratory is selected as the laboratory to output the print.

Appellant further argues that the affiliated laboratories in Shiotu are not unrelated as claimed. However, the Examiner notes that in Appellant's specification, the unrelated service providers are referred to as member providers (see page 7, lines 11-15 and page 8, lines 1-12). The affiliated laboratories in Shiotu are similar to the member providers of the instant application in that they represent different service providers who have registered with the described network.

Finally, with respect to Nguyen reference, Examiner noted that Nguyen was used to disclose the teaching of a list of unrelated service providers only. Appellants arguments directed to other limitations that were not used by the Examiner with respect to the Nguyen reference are considered to be moot.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/A. V./

Examiner, Art Unit 3691

Conferees:

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691